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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/546,575 | 04/10/2000 | Fergal John Mohan | 74937/0269804 | 3406 |

27498 7590 05/17/2006

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| EXAMINER | |
|---|---|
| BOCCIO, VINCENT F | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2621 | |

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/546,575 | MOHAN ET AL. | |
| | Examiner | Art Unit | |
| | Vincent F. Boccio | 2621 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on *01 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,3-9,11-16 and 19-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-9,11-16 and 19-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

***DETAILED ACTION***

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2621.

***Response to Arguments***

Applicant's arguments filed 3/1/06 have been fully considered but they are not persuasive.

(A) In re page 8, applicant states, "The examiner does not show how the parsing of URLs can render obvious a DVD Text Data parser that parses or indexes a DVD Text Data Structure such as a TXTDT_MG which maintains plural URLs. Absent ***use of hindsight***, the claimed DVD Text Data Parser that derives data containing a URL would have not been obvious …".

In response, applicant has never argued to identify, why the prior art does not have a text parser.

The definition of a Text parser is met by Kanazawa, Fig. 16 see SOFTWARE block (right corner, "SOFTWARE"), including the navigation manger 201, being software, deriving or extracting or de-multiplexing a URL, as clearly shown, is a text parser because a text parser is defined below.

Parser, a software tool that parsers text, since the navigation manager receives a stream from the DVD, wherein the Navigation Manager 201 is software, anticipates the claims and argued TEXT DATA PARSER, being software parsing text, no other disclosure is deemed necessary to those skilled in the art.

Since it is known with respect to DVD having area set fourth for storing text data, wherein the management area such as TXTDT MG is a well known text data manager and wherein the URL is text, the area defined as TXTDT manager is a data structured area for storing text, wherein Kanazawa stores URL text, the area defined as a manager or managing text being an area, suggests in itself to store text in a manager area for storing text, while Kanazawa already stores the URL being text, therefore, based on the above renders obvious to utilize a manager areas already set forth for text to store any text in that set fourth area, set fourth for text, as is deemed obvious to those skilled in the art.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based

upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(B) In re page 6, applicant states, "Kanazawa does not anticipate using a GPRM …".

In response Kanazawa has not been relied upon for this teaching.

(C) In re page applicant states, "Kanazawa would not have been motivated an ordinary skilled artisan to store such information in a GPRM."

In response, Kanazawa stores the return position data in a register, never mentions the type of register and further does not mention the utilization of a GPRM, but, one cannot come to a conclusion that it would not have been obvious in view thereof.

Clearly Kanazawa ***does not teach away*** from using a specific known register, such as GPRM/GPRMs.

Further if Kanazawa made suggestion, the limitation may be anticipated, rather then deemed obvious in view of Watkins.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, based on Watkins,

- col. 6, "a plurality of navigation commands act as instructions to set system parameters"
- col. 10, "16 parameter registers for general use … which could be used in interactive titles such as quizzes and games … set system parameter instructions used to set the value of various system parameters.".

Based on above Watkins suggests that GPRM registers are known and utilized for system parameters, these are used in interactive titles.

Kanazawa provides for an interactive title.

Kanazawa uses some sort of register to store the return address with respect to the interactive title, upon user interaction.

Clearly by selecting the WEB button is associated with at least one Navigation command (Navigation Manager) and the interactive title or DVD.

Therefore the arguments are not deemed persuasive.

(D) In re page 7, applicant states, "Kanazawa and no benefit could be accrued from using a GPRM register whose form and function is assigned by the DVD specification. On the contrary, a skilled artisan would have been strongly motivated to avoid using GPRMs … Nor does Watkins provide any teaching or suggestions of writing indicia of a current position of play within the DVD into the GPRM.".

In response, it is understood by the examiner that Kanazawa actually performs every part of the claim, except for using a specific register known to DVD systems and TXTDT_MG data, claim 1 (narrowest claim).

No benefit, except that Watkins describes known GPRM registers for interactive titles storing various system parameters, established knowledge that can be utilized by skilled artisans to author or create interactive titles or the storage of the system parameters such as current play position for the purpose of RESUMING REPRODUCTION USING THE STORED POSITION DATA.

Skilled artisans would/could utilize the teaching of Watkins thereby selecting GPRM registers for that purpose, instead of inventing a new means to enable the interactivity or reinventing the WHEEL, while already suggested, those skilled artisans would be alleviated on this issues as taught by Watkins, being known to utilize GPRMs for interactive titles to store various system parameters, as is suggested by Watkins.

(E) In re page 7, applicant states, "It would have been readily apparent to a skilled artisan that manipulations of even a single bit in a GPRM would have substantial consequences of validating of a DVD.".

In response the passage does not suggest the conclusion of applicant, further changing a single bit would have substantial consequences of validating of a DVD, is not supported by Watkins.

It is noted that the examiner deems that Watkins does provide a teaching and suggestion to utilize established GPRM registers and the DVD specification and system established methods for utilizing GPRM register for storing system parameters and TXTDT_MG text areas for text, wherein the URL is text, already established for interactive titles in Kanazawa.

It is further noted that motivation can be either established, one of many ways, where there is some teaching, suggestion, or motivation to do so found ***either in the references themselves or in the knowledge generally available to one of ordinary skill in the art***. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
>
> This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 4, 6-9, 11, 13-16, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanazawa et al.(US 6,580,870) in view of Watkins (US 6,230,295).

The examiner incorporated by reference the previous action against the claims.

Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanazawa et al.(US 6,580,870) in view of Watkins (US 6,230,295) and further in view of Wang et al. (US 6,173,406).

The examiner incorporated by reference the previous action against the claims.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Contact Fax Information***

Any response to this action should be faxed to:

(571) 273-8300, for communication as intended for entry, this Central Fax Number as of 7/15/05

***Contact Information***

Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Tuesday & Thursday-Friday, 8:00 AM to 5:00 PM Vincent F. Boccio (571) 272-7373.

Primary Examiner, Boccio, Vincent
5/13/06